

PRELIMINARY AMENDMENT  
Application Serial No. 09/513,207  
Attorney Docket No. 07648.0002-00000

REMARKS

Applicants filed a Request for Continued Examination in this application on January 21, 2004, in which reconsideration and entry of the Amendment After Final dated November 24, 2003, was requested. With the entry of that Amendment, claims 1-6, 8-12, and 14-24 are now pending. Applicants now provide this Preliminary Amendment with additional claim amendments based upon those filed in the Amendment After Final. With these amendments presented herein, claims 1-6, 8-12, and 14-24 are still pending and claims 2-3, 11-12, and 14-24 have been amended. Applicants respectfully request the entry and the Examiner's consideration of these amendments before the preparation of the next Office Action.

In the Advisory Action dated January 6, 2004, the Examiner noted that he did not enter the Amendment After Final because that paper raised new issues. First, the Examiner questioned the limitations provided in claims 2 and 12 in light of the recitation of an "attenuated total reflectance device" in claims 1 and 11. Claims 2 and 12 have been amended herein to specify that the ATR device of claims 1 and 11 is "an ATR-UV optical probe." The specification explains in at least bottom paragraph of page 5 that "the analyzer of the present invention can be installed directly in a pulping liquor stream as a probe or can be incorporated as part of a sample system as a flow cell." One of ordinary skill in the art would understand claims 1 and 11 to be further limited by defining the ATR device as an ATR-UV optical probe and installing that probe directly in the kraft liquor stream. For the same reason, one of ordinary skill would read claims 3 and 14 as defining the ATR device as an "ATR-UV tunnel flow cell" that is "incorporated

PRELIMINARY AMENDMENT  
Application Serial No. 09/513,207  
Attorney Docket No. 07648.0002-00000

as part of a sample system." Therefore, these amendments to claims 2 and 12 do not add new matter and Applicants respectfully submit that these claims properly depend from and further limit the subject matter recited in claims 1 and 11.

Second, in the Advisory Action the Examiner stated that "in claim 11 the language used to incorporate the liquid kraft pulp stream into the claims is acceptable for a method claim, but is not clear as an apparatus limitation." Applicants have herein amended claim 11 to recite "a liquid kraft pulp stream source." Applicants believe that this language is appropriate for a "system" claim and properly recites that the system acts upon the liquid kraft pulp streams provided by the recited source. Applicants submit that this amendment does not add any new matter to the specification.

Third, in the Advisory Action the Examiner noted that claims 23 and 24 did not further limit the claims from which they depend because they do not recite a "structure to cause dilution of the sample." Applicants have herein amended claims 23 and 24 to specify that "the kraft liquor stream is undiluted." The specification, in at least the first paragraph on page 11, indicates that "the elimination of the need to dilute the stream sample" is one advantage of the inventive system; however, the sample stream for analysis according to the present invention may be either diluted or undiluted. With claims 23 and 24, therefore, Applicants further limit the claims by specifying that the sample stream is undiluted. One of ordinary skill would understand that claims 23 and 24 further limit their parent claims by reciting "undiluted" as a negative limitation on the claimed systems. These claims recognize the absence of structure by denying the presence of a structure that may cause dilution of the sample, or at least by saying that any such diluting structure that may be present is not used. In fact, any suggestion that

PRELIMINARY AMENDMENT  
Application Serial No. 09/513,207  
Attorney Docket No. 07648.0002-00000

the claims must recite a diluting structure only to then say that no dilution occurs is unfounded, as there is no requirement for a claim to recite a structure in a system that is not used by the claimed system. See MPEP § 2173.05(i). Because claims 23 and 24 further limit their parent claims, and because one of ordinary skill would recognize the limitations recited, Applicants respectfully request that the Examiner's objection to claims 23 and 24 be withdrawn.

The remaining amendments to the claims either merely correct typographical errors or conform the terminology of dependent claims to each other and to their parent claims. Applicants submit that no new matter is added by these amendments.

The Examiner did not further discuss the claim rejections under 35 U.S.C. §§ 102(b) and 103(a); however, Applicants believe that the arguments and remarks submitted in the Amendment After Final, taken in combination with the present amendments, should be sufficient to overcome these rejections. Applicants therefore respectfully request the allowance of the pending claims.

If, after considering the amendments and remarks, the Examiner does not believe the pending claims of this application to recite allowable subject matter, Applicants request that the Examiner contact the undersigned by telephone at 404-653-6460, or Robert Stanley at 404-653-6441, to discuss any remaining objections or rejections.

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Attorney Docket No. 07648.0002-00000

If there is any fee due in connection with the filing of this Preliminary  
Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
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Dated: March 4, 2004

By: Lori-Ann Johnson  
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-10-